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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,323	07/13/2005	Frederic Demarne	1759.204	8915
23405	7590	05/30/2007		
HESLIN ROTHENBERG FARLEY & MESITI PC 5 COLUMBIA CIRCLE ALBANY, NY 12203			EXAMINER MCCORMICK, MELENIE LEE	
			ART UNIT 1655	PAPER NUMBER
			MAIL DATE 05/30/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/542,323	Applicant(s) DEMARNE ET AL.	
	Examiner Melenie McCormick	Art Unit 1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 09 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The amendments with remarks submitted 11/09/2006 have been received and entered.

Claims 1-23 are presented for examination on the merits.

Claim Rejections - 35 USC § 112

The amendment filed on 11/09/2006 is sufficient to overcome the rejection of claims 4, 12-14, and 17 under 35 U.S.C. 112, second paragraph.

The rejection has been withdrawn.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11 and 15 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sanou et al. (US 5874,401) for the reasons set forth in the previous Office Action and restated below.

The claims are drawn to an extract of *Cryptomeria japonica*.

Sanou et al. disclose an extract of *Cryptomeria japonica* which appears to be identical to the presently claimed extract composition, since it was extracted via the same essential steps as instantly claimed - i.e., first performing an aqueous extraction of a flower (which reads on the bud instantly claimed) of *Cryptomeria japonica*, then performing a solid/liquid separation step (centrifugation), and then a liquid phase retrieval step (a second centrifugation) (see e.g. col 3, lines 34-47). Consequently, the claimed *Cryptomeria japonica* extract composition appears to be anticipated by the reference.

In the alternative, even if the claimed extract composition is not identical to the referenced extract composition with regard to some unidentified characteristics, the differences between that which is disclosed and that which is claimed are considered to be so slight that the referenced extract composition is likely to inherently possess the same characteristics of the claimed extract composition particularly in view of the similar characteristics which they have been shown to share. Thus, the claimed extract composition would have been obvious to those of ordinary skill in the art within the meaning of USC 103.

Accordingly, the claimed invention as a whole was at least *prima facie* obvious, if not anticipated by the reference, especially in the absence of sufficient, clear, and convincing evidence to the contrary.

Applicants argue that the *Cryptomeria japonica* bud extract composition taught by Sanou et al. does not anticipate the instantly claimed *Cryptomeria japonica* extract because the extract of Sanou et al. does not teach that the extract is obtained from a stem bud. This is not persuasive, however, because the instant claims are drawn to a bud, not a stem bud. Sanou et al. teach a *Cryptomeria japonica* flower extract which, as previously stated, is obtained by the same essential steps as instantly claimed. The flower extract taught by Sanou et al., therefore, reads on the instantly claimed bud extract, as broadly interpreted. Please note that, as previously stated in the instant rejection under 35 U.S.C. 102/103, even if the claimed extract composition is not identical to the referenced extract composition with regard to some unidentified characteristics, the differences between that which is disclosed and that which is claimed are considered to be so slight that the referenced extract composition is likely to inherently possess the same characteristics of the claimed extract composition particularly in view of the similar characteristics which they have been shown to share. Thus, the claimed extract composition would have been obvious to those of ordinary skill in the art within the meaning of USC 103.

Applicants further argue that the composition taught by Sanou et al. does not render obvious the instantly claimed composition because one of ordinary skill in the art would not be motivated to use the teaching of Sanou et al. in order to obtain a composition as instantly claimed. This is not persuasive, however, as the skilled artisan would be motivated to perform essentially the same steps as instantly disclosed in order to obtain a *Cryptomeria japonica* extract as instantly claimed since, as previously stated, these steps were disclosed by Sanou et al.. Applicants further argue that Sanou et al. disclose the composition, a pollen, as being useful as a desensitizing agent. While this

teaching is provided by Sanou et al., this intended use does not render the instantly claimed composition non-obvious. The claims broadly read on essentially the same composition as that taught by Sanou et al. Applicants also argue that Sanou et al. teach obtaining the *Cryptomeria japonica* extract from the flower and not the stem bud. As previously stated, the claims are drawn to an extract from a bud of *Cryptomeria japonica*, not a stem bud. The skilled artisan would be motivated to use the flower bud in order to obtain pollen as taught by Sanou et al.

The rejection is thus deemed proper and is maintained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanou et al. (US 5874,401) in view of Matsushashi et al. (US 5,073,628) for the reasons set forth in the previous Office Action and restated below.

An extract of *Cryptomeria japonica* D. Don buds and a method of using the extract is claimed.

Sanou et al. beneficially teach an extract of the flower of *Cryptomeria japonica* and is relied upon for the reasons set forth above. Sanou et al. beneficially teach that

the extract of *Cryptomeria japonica* was extracted by first performing an aqueous extraction of a flower (which reads on the bud instantly claimed) of *Cryptomeria japonica*, then performing a solid/liquid separation step (centrifugation), and then a liquid phase retrieval step (a second centrifugation) (see e.g. col 3, lines 34-47). The extract beneficially taught by Sanou et al. reads on the extract instantly claimed. It is expected that the characteristics of the extract beneficially taught by Sanou et al. would be the same as those of the instantly claimed extract, since it was extracted using the same basic process as instantly claimed. It is further beneficially taught by Sanou et al. that the extract may be supplied in the form of an ointment (see e.g. col 15, lines 30-35) and that the composition may administered per mucosally, in which case the composition would intrinsically be applied to epidermal cells (see e.g. col 16, line 17).

Matsushashi et al. beneficially teach a cream or lotion which contains a cedar pollen allergen (see e.g. claim 25) and may be administered percutaneously (see e.g. col 4, lines 23-30). The cedar pollen allergen beneficially taught by Matsushashi et al. was obtained by the extraction of Omote Sugi (*Cryptomeria japonica*), and would have intrinsically come from the flower of the plant.

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to make an extract from the flower (bud) of *Cryptomeria japonica* in the manner beneficially taught by Sanou et al. and supply the extract in the form of a cream or lotion for application to the skin as beneficially taught by Matsushashi et al. One of ordinary skill in the art would have been motivated to do so based upon the beneficial teachings of Sanou et al., which disclose that the *Cryptomeria japonica*

extract composition may be in the form of an ointment (see e.g. col 15, lines 30-35). Stimulation (or cryoprotection or normalizing or moisturizing) of the dermal cells would intrinsically occur upon the inevitable application to the skin of such a composition. The adjustment of particular conventional working conditions (e.g. the particular dry matter content of the extract or the particular percent by weight of the extract within the composition) is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Applicants argue that Matsushashi et al. does not teach that the *Cryptomeria japonica* extract is obtained from stem buds. As previously stated, the instant claims are broadly drawn to buds, not stem buds. One of skill in the art at the time the claimed invention was made would have been motivated to use a flower bud of *Cryptomeria japonica* in order to obtain the composition beneficially taught by Matsushashi et al., especially since it is well known in the art that pollen may be obtained therefrom. Applicants admit that Matsushashi et al. teach that *Cryptomeria japonica* is useful for the same purpose as disclosed by Sanou et al. Therefore, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to make an

Art Unit: 1655

extract from the flower (bud) of *Cryptomeria japonica* in the manner beneficially taught by Sanou et al. and supply the extract in the form of a cream or lotion for application to the skin as beneficially taught by Matsushashi et al. One of ordinary skill in the art would have been motivated to do so based upon the beneficial teachings of Sanou et al., which disclose that the *Cryptomeria japonica* extract composition may be in the form of an ointment (see e.g. col 15, lines 30-35). The instantly claimed functional effects would have intrinsically have occurred upon the inevitable topical application to the skin of such a composition.

The rejection is deemed proper and is maintained.

Conclusion

No claim is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melenie McCormick whose telephone number is (571) 272-8037. The examiner can normally be reached on M-F 7:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Melenie McCormick
Examiner
Art Unit 1655



CHRISTOPHER R. TATE
PRIMARY EXAMINER